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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,261	02/18/2000	Robert J. Safranek	2791-52913	9010

25253 7590 10/05/2004

IBM CORPORATION
IP LAW DEPT, ED02-905
15450 SW KOLL PARKWAY
BEAVERTON, OR 97006-6063

EXAMINER

ELMORE, REBA I

ART UNIT	PAPER NUMBER
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2187

DATE MAILED: 10/05/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/507,261	Applicant(s) SAFRANEK ET AL.	
	Examiner Reba Elmore	Art Unit 2187	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on decision by the Board.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of the Decision by the Board of Patent Appeals and Interferences mailed on May 20, 2004, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant should exercise the following option :

(1) file a reply under 37 CFR 1.111 (since this Office action is non-final).

Claims 1-20 are pending in the instant application and are the subject of the following action from the examiner.

Claim Rejections under 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 18 contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 18 states that the *state machine monitors whether an invalidate message for data is received after issuing a request for a shared copy of the data and in response to the*

invalidate message issues a request for an exclusive copy of the data. However, the applicant's disclosure fails to teach how to make and /use the state machine in an manner where the state machine is able to ***issues a request for an exclusive copy of the data.***

The applicant's specification on page 4 in the last full paragraph indicates that the remote node ***issues a request for an exclusive copy of the data*** and the state machine ensures that the request for an exclusive copy of the line is issued by the remote node.

The applicant's specification on page 9, in the first 3 lines of that page indicate that *"if, an invalidate message is received when in state 104, the state machine ensures that a request has been made for an exclusive copy of the line so that the remote node request be allowed to complete.* The applicant's disclosure fails to mention that the state machine ***issues a request for an exclusive copy of the data*** or how the state machine is capable of ***issuing a request for an exclusive copy of the data.***

Furthermore, per the decision by the Board of Patent Appeals and Interference dated May 20, 2004, claim 18 is the subject of a second rejection under 35 U.S.C. 112, first paragraph. More specifically, claim 18 is rejected on the grounds that is represents a single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983). Claim 18 represents a single means claim which covers every

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conceivable means for monitoring whether an invalidate message for data is received after issuing a request for a shared copy of the data and in response to the invalidate message, issuing a request for an exclusive copy of the data. The applicant's specification discloses at most only those means known to the applicants. (See MPEP 2164.08(a).

Claim 1-17, 19 and 20 are considered allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reba Elmore whose telephone number is (703) 305-9706. The examiner can normally be reached on Mon-Fri. from 7:30 to 6:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Sparks, can be reached on (703) 308-1756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

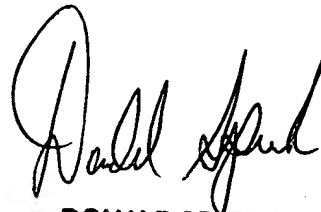
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**PETER WONG, DIRECTOR
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**DONALD SPARKS
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